

REMARKS

Claims 1-2 and 6-9 are pending in the present application. Claims 1, 6 and 8 are herein amended. No new matter has been entered.

Rejections under 35 USC §102(b)

Claims 1, 6 and 8 were rejected under 35 USC §102(b) as being anticipated by Deng et al. (U.S. Patent No. 5,980,977).

Responding to Applicants' previous response, the Examiner alleged as follows:

Applicant's arguments filed 11/25/2008 have been fully considered but they are not persuasive. Amended Independent claims 1, 6, and 8 recite the manner in which a claimed apparatus is intended to be employed and does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ F.2d 1647 (1987).

Claim 1 has been amended to recite "electric power source connected to said electrode." Claim 6 has been amended to recite "electric power source connected to said electrode." Claim 8 has been amended to recite "a membrane electrolyte assembly; and a collector for collecting electricity disposed on both sides of said membrane electrolyte assembly." These amendments do not introduce new matter because the newly recited elements are all **inherent and necessarily included** in a water electrolysis system, an organic electrolysis system or a fuel cell.

Claims 1, 6 and 8 are also amended for clarification to recite "wherein said metal oxynitride electrode catalyst having an oxygen reduction catalytic activity at a potential of 0.4 V or higher relative to the reversible hydrogen electrode potential in said acidic electrolyte." This amendment is supported in the original disclosure, for example, at paragraphs [0025] and [0026].

Deng et al. does not discuss a water electrolysis system or an organic electrolysis system at all. Regarding a battery, Deng et al describes as follows:

The thin layer metal oxynitride covered-substrate is useful for **electrical energy storage** as an electrode in a **capacitor** or **battery** configuration.

The present invention generally relates to an energy storage device, and more particularly to a **bipolar double layer capacitor-type energy storage device**, and to improved methods for manufacturing the same.

(Deng et al., column 1, lines 32-39). Deng et al. does not clearly describe the kind of battery it refers. From “**electrical energy storage** as an electrode in a **capacitor** or **battery** configuration,” it would be reasonable for a person skilled in the art that the term “battery” indicates rechargeable battery or secondary battery. The word “battery” mostly appears in Deng et al. as “capacitor or battery” without any further explanation. Another descriptions referring to “battery” discuss recharging (see Deng et al., column 62, lines 8-40). Thus, nothing in Deng et al. indicates a fuel battery which uses the electrode. Although the terms “cell” and “battery” are synonymously used, a fuel cell is completely different from a rechargeable battery.

Thus, Deng et al. does not teach or suggest a water electrolysis system which has “electric power source connected to said electrode,” as recited in claim 1. Also, Deng et al. does not teach or suggest “an organic electrolysis system” which has “electric power source connected to said electrode,” as recited in claim 6, and “a fuel cell” which has “a membrane electrolyte assembly; and a collector for collecting electricity disposed on both sides of said membrane electrolyte assembly,” as recited in claim 8.

For at least these reasons, claims 1, 6 and 8 patentably distinguish over Deng et al.

Rejections under 35 USC §103(a)

Claims 2, 7 and 9 were rejected under 35 USC §103(a) as being obvious over Deng et al. (U.S. Patent No. 5,980,977) in view of Clerc et al. (U.S. Patent No. 6,190,802).

Claim 2 depends from claim 1. Also claim 7 depends from claim 6, and claim 9 depends from claim 8. Because claims 1, 6 and 8 patentably distinguish over Deng et al., claims 2, 7 and 9 also patentably distinguish over Deng et al.

Clerc et al. has been cited for allegedly disclosing a metal oxynitride electrode catalyst being dispersed as fine particles on a catalyst carrier which is an electronically conductive powder. Such disclosure of Clerc et al., however, does not remedy the deficiencies of Deng et al. discussed above.

For at least these reasons, claims 2, 7 and 9 patentably distinguish over Deng et al. and Clerc et al.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

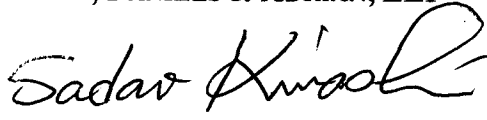
Application No.: 10/581,210
Art Unit: 2818

Amendment under 37 CFR §1.116
Attorney Docket No.: 062485

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Sadao Kinashi", with a stylized, flowing script.

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